

In the Advisory Action mailed April 5, 2001, in the parent application, Examiner Bawa maintained his rejection of claim 1 based on 35 U.S.C. § 102(b), for the reasons stated in the Final Office Action. The Examiner's rejection in the Final Office Action was based on his "ultimate legal conclusion ... that the subject matter defined by claim 1 would have been **obvious** within the meaning of 35 U.S.C § 102(b)." Final Office Action at page 2 (emphasis added).

Applicants maintain their firm position that such a rejection is improper and fundamentally misunderstands the requirements set forth by § 102. This section of the Patent Act pertains to anticipation of claims, not obviousness. In order for a reference to anticipate a claim, each and every element set forth in the claim must be found in the reference. See MPEP §2131. A claim therefore cannot be "obvious" under § 102. The Examiner's "ultimate legal conclusion" is therefore fundamentally flawed, and Applicants request that the rejection based on this section be withdrawn.

Applicants also reiterate their argument that even if the Examiner meant to state that claim 1 is anticipated under § 102(b), such a rejection is clearly incorrect. As noted above, an anticipation rejection is valid only if each and every element of a claim is disclosed in a single reference. The Examiner's reliance on *In re Bozek*, 163 U.S.P.Q. 545 (C.C.P.A. 1969) as stating that references are to be evaluated by what they suggest to one versed in the art is improper as well, since the court in *Bozek* was reviewing a § 103 obviousness rejection, not a § 102 anticipation rejection. Because neither of the references cited by the Examiner disclose each and every element of claim 1, Applicants request that the rejection be withdrawn.

The Examiner attempts to provide the elements lacking in the prior art by two methods. First, when confronted with the fact that neither reference discloses an aerosol device as claimed in claim 1, the Examiner states that aerosol devices are "well known in the art." Applicants submit that the Examiner has improperly relied on the general knowledge in the art because the relevant inquiry is whether all elements claimed in claim 1 are found in a single reference. The Examiner cannot rely on the general knowledge in the art to provide elements which are missing from a reference in an anticipate rejection.

The Examiner also attempts to rely on the theory of inherency to provide missing elements. According to the Examiner, "each and every element of claim 1 claimed is either identically disclosed by the cited art or clearly inherent." See Final Office Action at page 2. Applicants restate their request that, if the Examiner truly believes that each and every limitation is disclosed by a reference, the Examiner particularly point out where in a particular reference each element is disclosed.

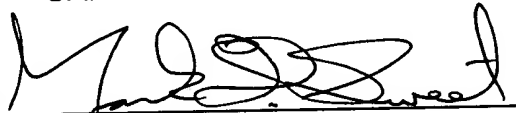
If, on the other hand, the Examiner intends to rely on inherency, Applicants request that the Examiner provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis added). The Examiner has failed to do this, instead stating merely that the element requiring an "initial flow rate of aerosol composition of less than or equal to 0.75 gram per second" is "not critical and clearly inherent to the analogous disclosure of Thomaidēs." See Advisory Action mailed April 5, 2001.

Applicants fail to see why the Examiner believes that the flow rate limitation in claim 1 is inherent in the cited reference. Nowhere does the reference lead one to believe that the disclosed compositions necessarily must be delivered at a flow rate below 0.75 gram per second, nor does the prior art disclose a device that delivers such a flow rate. Applicants therefore ask the Examiner to provide, as required by law, a "basis in fact and/or technical reasoning" to support his conclusion of inherency. Barring such a basis, Applicants request that the rejection be withdrawn.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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